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EXAMINER

YIGDALL, MICHAEL J

ART UNIT	PAPER NUMBER
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2192

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/862,825

Applicant(s)

UEDA, SATORU

Examiner

Michael J. Yigdoll

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 12, 2007 has been entered. Claims 1, 3, 4 and 10-12 are now pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant contends that "the Examiner's assertion defies logic because no reasonable individual would pay the full purchase price for software and then run it [in] an evaluation mode that precludes access to functions for which the user has already paid" (remarks, page 10).

However, as set forth in the Office action, Reeder teaches a purchased software program (see, for example, page 3, lines 11-15, and page 7, lines 30-37) that includes at least one supplemental pay function (see, for example, page 10, lines 18-27). The supplemental pay function is, of course, *supplemental* to the purchased software program. Notwithstanding the supposed buying decisions of a reasonable individual, a user who has already purchased the software program has not yet paid for access to the at least one *supplemental* pay function.

Applicant further contends that "no person of ordinary skill in the relevant art would expend time, money, and effort to develop and incorporate such an evaluation mode into a

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software product since adding the evaluation mode would neither encourage more people to purchase the product nor be used after the purchase of the product” (remarks, page 10).

However, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

As set forth in the Office action, Grundy teaches an evaluation mode that provides unlimited access to a software program without access to any supplemental pay functions so that the user may freely try and evaluate the software program without paying any additional fees (see, for example, column 4, lines 28-42 and 51-59). Combining the *teachings* of the references does not involve a direct and literal incorporation of Grundy’s evaluation mode into the system of Reeder. Rather, the teachings of Grundy would have suggested to those of ordinary skill in the art modifying the system of Reeder such that the user is granted unlimited access to the purchased software program without the at least one supplemental pay function when the user does not request access thereto, so that the user is allowed to try and evaluate the purchased software program without additionally paying for supplemental pay functions that are not requested. Indeed, this is what a reasonable individual would expect.

Applicant further contends, with reference to Grundy’s description of “shareware,” that “Grundy does not describe that a potential user pays the full purchase price, i.e., purchases the software, before evaluating the software (remarks, page 10-11, Applicant’s emphasis).

However, as set forth in the Office action, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Again, it is the Reeder reference that teaches or suggests a purchased software program (see, for example, page 3, lines 11-15, and page 7, lines 30-37). Nonetheless, as Applicant acknowledges, Grundy likewise describes a software program that is distributed for a nominal fee (remarks, page 10). A software program that is purchased for a nominal fee is still reasonably considered a "purchased software program," even if the nominal fee is less than the "full honorarium."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Pub. No. WO 97/14085 to Reeder (art of record, "Reeder") in view of U.S. Patent No. 4,658,093 to Hellman (art of record, "Hellman") in view of U.S. Patent No. 5,375,240 to Grundy (art of record, "Grundy") and in view of U.S. Patent No. 6,081,785 to Oshima et al. (art of record, "Oshima").

With respect to claim 1 (currently amended), Reeder teaches a software program providing system for providing and managing access to a purchased software program (see, for example, FIG. 1 and page 3, lines 11-15), said system comprising:

a storage medium for storing the purchased software program and for storing an individual identification code that uniquely identifies said storage medium (see, for example, store 150 in FIG. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium, and see, for example, page 7, lines 30-37, which shows that the software program is purchased), the purchased software program including at least one supplemental pay function (see, for example, page 10, lines 18-27, which shows a plurality of supplemental pay features or functions);

a user terminal for receiving said storage medium therein and for accessing the purchased software program stored in said storage medium (see, for example, apparatus 100 in FIG. 1, and page 3, lines 11-15 and line 32 to page 4, line 6, which shows a personal computer or user terminal receiving a storage medium therein for storing and accessing software programs, and see, for example, page 5, lines 10-14, which shows obtaining the software program and storing it in the storage medium);

database management means for managing the at least one supplemental pay function, said database management means including a database for storing individual information of a user, information regarding a range of access limitations to the purchased software program, and information regarding a condition of access to the software program, and which is searchable using the individual identification code as a search key (see, for example, code data 230 and bill

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log 240 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code), the information regarding the range of access limitations including information identifying the at least one supplemental pay function (see, for example, page 10, lines 18-27, which shows information identifying the supplemental pay features or functions), the information regarding the condition of access including an associated number of used counts for the at least one supplemental pay function, the associated number of used counts indicating the number of prior accesses by the user to the at least one supplemental pay function (see, for example, page 11, line 31 to page 12, line 14, which shows an associated record or count of each use of the feature or function).

Reeder teaches an associated message number (see, for example, page 11, lines 8-19) that is incremented when a feature or function is purchased (see, for example, column 10, lines 31-34), but does not expressly disclose the information regarding the condition of access including an associated number of purchased counts for the at least one supplemental pay function, the associated number of purchased counts indicating the number of prepaid accesses to the at least one supplemental pay function that are permitted to the user.

However, Hellman teaches a system for distributing and managing access to a software program (see, for example, the abstract), including an associated number of purchased counts that indicates the number of prepaid accesses to the software program (see, for example, column 10, lines 8-13). The system enables the use of the software program to be authorized for a particular user terminal a specific number of times (see, for example, column 4, lines 37-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to include an associated number of purchased counts indicating the number of prepaid accesses to a given one of the plurality of supplemental pay functions that are permitted to the user, so as to authorize the use of the supplemental pay function for a specific number of times, as Hellman suggests.

Reeder in view of Hellman further teaches said database management means including fee charging means for charging a fee to add to the associated number of purchased counts for the at least one supplemental pay function (see, for example, page 9, lines 25-27, which shows fee charging means for charging a fee to access the supplemental pay functions, and page 13, lines 7-15, which shows that access to the functions may be prepaid, and see, for example, Hellman, column 5, lines 51-56, which shows charging a fee to add to the associated number of purchased counts).

Reeder in view of Hellman further teaches:

information communication means for connecting said database management means with said user terminal (see, for example, communications link 10 and network 20 in FIG. 1, and page 3, lines 21-31).

Reeder does not expressly disclose that when the user does not request access to the at least one supplement pay function of the purchased software program, said software program authorizing said user terminal to have an unlimited number of accesses to the purchased software program without the at least one supplemental pay function.

However, Grundy teaches a system for distributing and managing access to a software program that includes authorizing unlimited access to the software program in evaluation mode

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without any supplemental pay functions when full-function mode is not requested, so that the user may freely try and evaluate the software program without paying any additional fees (see, for example, column 4, lines 28-42 and 51-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder such that the software providing system authorizes said user terminal to have an unlimited number of accesses to the purchased software program without the at least one supplemental pay function when the user does not request access to the at least one supplemental pay function, as Grundy suggests, so as to allow the user to try and evaluate and the purchased software program without paying additional fees for supplemental pay functions that are not requested.

Reeder in view of Hellman and Grundy further teaches:

said user terminal including a display having a graphical-unit-interface for enabling the user to select between requesting access to the purchased software program without the at least one supplemental pay function and requesting access to the purchased software program including the at least one supplemental pay function (see, for example, Grundy, column 12, lines 6-24, which shows a graphical user interface on which the software program displays a banner page to enable the user to select between requesting unlimited access to the software program in evaluation mode and paid access to the software program in full-function mode).

Reeder in view of Hellman and Grundy further teaches that when the user requests access to the at least one supplemental pay function of the software program,

said software program reading out the individual identification code that uniquely identifies said removable storage medium and then sending the read out individual identification

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code and the information identifying the at least one supplemental pay function over said information communication means to said database management means (see, for example, page 10, lines 6-17, which shows reading and sending an identification code from a storage medium, and page 10, lines 18-27, which further shows information identifying the supplemental pay features or functions),

said database management means reading out the associated number of purchased counts and the associated number of used counts based on the individual identification code and the information identifying the at least one supplemental pay function and then transmitting the associated number of purchased counts and the associated number of used counts over said information communications means to said user terminal (see, for example, page 11, lines 15-29, which shows transmitting a return message to the user terminal based on the identification code and the information identifying the supplemental pay feature or function, and see, for example, Hellman, column 6, lines 3-8, which further shows transmitting the associated number of purchased counts relative to the number of times the software program was used),

said software program authorizing said user terminal to have at least one access to the purchased software program including the at least one supplemental pay function when the associated number of purchased counts exceeds the associated number of used counts and then communicating over said information communication means to said database management means when the access to the at least one supplemental pay function is concluded (see, for example, page 7, lines 30-37, and page 9, lines 25-27, which shows authorizing at least one access to the software program including the supplemental pay feature or function, and see, for example, Hellman, column 10, lines 33-54, which further shows authorizing access to the

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software program when the associated number of purchased counts is greater than 0, i.e. when it exceeds the number of times the software program was used),

said database management means then incrementing the associated number of used counts (see, for example, page 11, line 31 to page 12, line 14, which shows incrementing the associated record or count for each use of the feature or function).

Reeder does not expressly disclose that said storage medium is a removable storage medium.

However, Oshima teaches a system for providing and managing access to a software program stored with an identification code on a removable, optical storage medium, wherein the software is installed on a user terminal from the removable storage medium, for the purpose of preventing illegal copying of the software (see, for example, column 10, lines 15-54, and see, for example, FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium for receipt at the user terminal, as Oshima suggests. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 3 (previously presented), the rejection of claim 1 is incorporated, and Reeder in view of Hellman, Grundy and Oshima further teaches that said information communication means further comprises ciphering means for ciphering communication between said database and said user terminal (see, for example, page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 4 (previously presented), the rejection of claim 1 is incorporated. Reeder teaches the use of encryption to provide additional security (see, for example, page 5, line 33 to page 6, line 1), but does not expressly disclose that said storage means further comprises a DVD-ROM, and the individual identification code includes a BCA code recorded using a laser beam during a fabrication process of the individual identification code.

However, Oshima further teaches the use of the BCA to store an identification code and a cryptographic key (see, for example, column 1, lines 36-50) on a DVD (see, for example, column 3, lines 63-67), so that a fee may be charged for the use of the disk (see, for example, column 4, lines 60-64). Oshima further teaches that the BCA code is recorded with a laser during fabrication and can be used for security (see, for example, column 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to use a DVD-ROM storage medium with a BCA identification code, as Oshima suggests. The modification would have been obvious because one of ordinary skill in the art would have been motivated to improve security by transcribing the storage medium with an individual identification code.

With respect to claims 10 (currently amended), 11 and 12 (new), the claims are directed to a software program providing system, the elements of which are similarly addressed in the rejection of claims 1, 3 and 4 above, respectively (see the rejection of claims 1, 3 and 4 above).

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MY

Michael J. Yigdall
Examiner
Art Unit 2192

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